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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,833	03/30/2001	Steven Lemay	IGT1P118/P-303	6122
22434	7590	05/27/2004	EXAMINER	
BEYER WEAVER & THOMAS LLP			ENATSKY, AARON L	
P.O. BOX 778			ART UNIT	
BERKELEY, CA 94704-0778			PAPER NUMBER	
			3713	

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/823,833	<b>Applicant(s)</b> LEMAY ET AL.	
	<b>Examiner</b> Aaron L Enatsky	<b>Art Unit</b> 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-54 and 58 is/are pending in the application.
- 4a) Of the above claim(s) 55-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-54, 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

Examiner acknowledges receipt of the Response to Office Action on 03/12/04.

### ***Election/Restrictions***

Newly submitted claims 55-57 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims are directed to a method of code authentication where code is transmitted multiple times between a game machine controller and a peripheral device, then compared at a game machine controller for authentication purposes.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 55-57 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has required that a gaming machine does not need to physically access a peripheral device. Examiner is unsure of the exact meaning of no physical access and has

Art Unit: 3713

interpreted the claim to mean that the peripheral device does not need to be built into the gaming machine or is remote from the gaming machine. Examiner believes the plain meaning of no physical access would raise possible enablement issues, as no physical access would mean the lack of communication between the two devices.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, *if* the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37-40, 42, 44, 46-49, 50-54, 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,263,392 to McCauley in view of Request For Comments: 951 by Croft et al. ("Croft"). In regard to claims 37, 42, 48, and 58 McCauley teaches a method and apparatus for interfacing peripheral devices to a host computer (Abstract). The peripheral devices include controllers and monetary authentication devices (Abstract), which effect operability of the host game machine. The peripheral devices also contain control code for interfacing with the host machine and other peripheral devices (1:34-2:20). Furthermore, the system was built to meet a long felt need to increase energy efficiency and reduce cost and complexity of computer interface hardware designs (2:35-38). McCauley does not however detail a host device providing control code necessary to operate peripheral devices. Croft teaches a client machine connected to a server machine in which the client machine sends a BOOTP or bootstrapping request to the

server and the server provides a bootfile, otherwise known as operating code, to be loaded into memory and executed by the client machine (Page 1). Croft teaches such a system to provide an unattended power-up to a machine that lacks permanent operating code storage (Page 1). Other well-known reasons behind remote bootstrapping is efficient software updating without requiring manual software updating on every peripheral device in use. Croft's steps include transmitting control code from a host in response to a client request, storing control code at the client machine, and executing control code at the client machine (Page 1-2). One would be motivated to modify McCauley to include automatic operating code downloads in peripheral devices taught by Croft because automated system maintenance would aid in reducing cost and complexity of computer interface hardware designs, which is a major impetus for McCauley's system design. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McCauley to use the automatic operating code downloads taught by Croft to reduce cost and complexity of the peripheral devices. Additionally, in the case of updated software, Applicant's additional requirement for a portion of code different from previous code would be satisfied.

In regard to claim 38 and 46, Croft teaches that a client device need only contain code enough to request operating control code from a host device (Page 1).

In regard to claims 39-40, Croft teaches downloading control code during boot operation (Page 1), which would happen during every system power-up including removing power from the device.

In regard to claim 44, Croft teaches a controller identifies client device to transmit control code (Page 3).

1). In regard to claim 47, Croft teaches use read-only memory for storing resident code (Page 1).

In regard to claim 49, McCauley teaches using USB as one of plurality of interfaces for connecting peripheral devices to a host machine (2:40-62).

In regard to claim 50, McCauley teaches game machine (Fig. 2, ref. 4) controls peripheral devices (Fig. 2, ref. 40, 42, 44, 46), which would be considered a master controller.

In regard to claim 51, McCauley, teaches peripheral devices are remote from the gaming machine (Fig. 2) so they do not need to physically access the gaming machine.

In regard to claim 52, McCauley teaches that the system can have multiple peripheral devices of the same type (Fig. 2) or a variety of different devices (6:23-34).

In regard to claims 53-54, McCauley teaches that the peripheral devices can be connected via parallel or serial lines in bi-direction communication (6:23-46). In the case of parallel connections, the devices can communicate or be given data at the same time.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCauley in view of Croft as applied to claims 3 7-40, 42, 44, 46-49 above, and further in view of US Patent No. 6,052,779 to Jackson et al. ("Jackson"). McCauley in view of Croft teaches the limitations as discussed above, but does not teach sending a polling signal to peripheral devices and peripheral devices responding by sending a control code request. Jackson teaches a polling request sent to client systems from a controlling system that causes client systems to respond by sending a control code request to the controlling system (Abstract). Jackson teaches such an operation to allow client device startup before a target start-up time (Abstract). One would be motivated to modify McCauley in view of Croft to use the remote polling taught by Jackson to allow greater remote control over peripheral devices which would further reduce the maintenance costs by

Art Unit: 3713

through further automation. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McCauley in view of Croft to include remote polling taught by Jackson for increased cost reductions.

Claims 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCauley in view of Croft as applied to claims 37-40, 42, 44, 46-49 above, and further in view of US Patent No. 5,802,592 to Chess et al. ("Chess"). McCauley in view of Croft teaches the limitations as discussed above, but does not teach control code authenticating before transmitting control code or periodically verifying control code. Chess teaches a system and method for protecting integrity of control code (Abstract), which involves authenticating control code during the bootstrapping process (2:51-67). Chess also teaches regularly verifying authenticity of the control code contents (Abstract). One would be motivated to modify McCauley in view of Croft to use bootstrapping authentication taught by Chess as Chess teaches that verifying control code is important to detect accidental or malicious code changes (1:10-60). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McCauley in view of Croft to use bootstrapping authentication taught by Chess to increase system security.

### ***Response to Arguments***

Applicant's arguments with respect to claims 37-54, 58 have been considered but are not considered persuasive.

**Use of Non-analogous Art in the Gaming Machine Industry:** Applicant holds that combinations used in the Examiner's rejection comprise non-analogous art in the gaming

Art Unit: 3713

machine industry. In response to applicant's argument that McCauley, Croft, Jackson, and Chess are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references in question predominantly deal with features previously known in peripheral devices or devices remote from a main computer. Applicant provides arguments toward the notion that because gaming machines come under very different and stringent government regulatory control versus personal computers (PCs), PC technology does not apply to Applicant's invention. For one, McCauley teaches peripheral devices in a PC game machine, including credit and coin-op devices such as found in gaming machines (Abstract). McCauley also details that the method of communication between the game machine and the peripheral device can be formatted data and signal packets according to a pre-established communications standard such as known in the art (10:20-28). Accordingly, Examiner applied elements from known communication standards as suggested by McCauley to arrive at Applicant's invention. Thus, Examiner believes that the prior art was in a field of Applicant's endeavor, wherein the prior art teaches sending operating code to remote devices.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

Art Unit: 3713

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALE

JOHN M. HOTAKING, II  
PRIMARY EXAMINER

